

REMARKS

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Vatter, U.S. Patent No. 6,696,049 alone, or if necessary, in view of McDermott, U.S. Patent No. 6,248,336 and Shah, WO00/47168. The Examiner states:

*The claims are drawn to a water and oil emulsion composition comprising at least one silicone resin film forming polymer, at least one silicone/acrylate copolymer or a vinyl/silicone copolymer or mixture thereof, at least one organic pigment where water is in an amount of 0.1-95% and oil is in an amount of 0.1-99% by weight. Vatter's patented composition used for skin care products (e.g. eye make-up products such as eye shadow) comprising at least one silicone resin film forming polymer and silicone-acrylate type copolymers such as SA70, see col. 12, lines 38-48. The colorants comprising inorganic or organic pigments are taught at col. 17, lines 10-45. Furthermore, US'049 (hereinafter) teaches water (0-95%, see col. 10, lines 45-47) and oils including linear volatile silicone oils (cols. 8, lines 41-58; col. 10, lines 40). Viscosity agent, volatile solvent, non-volatile oil, a dry particulate matter, etc are taught by the cited reference throughout the patented disclosure. As mentioned in previous office action, the variations are considered to be minor and the modifications are routinely practiced (see Cosmetics, Science and Technology: color in Cosmetics, Chapter 44 (1957) by Samuel Zuckerman, previously provided). Thus, it is the examiner's position that one having ordinary skill in the art would readily recognize that how to modify the formulation utilizing the ingredients taught and suggested by Vatter's to make the final cosmetic composition to satisfy user's need with better appearance and quality when Vatter's reference is taken alone or if necessary, taken in view of Shah and McDermott (their teachings are mentioned in previous office action) because it is well within the skill of those having ordinary skill in the art to adjust and employ different ingredients to arrive at a desired quality. Although all the elements are not specifically included in any examples, one of ordinary skill in the art would have been readily understand and modify with proper substitution as suggested by Vatter's teaching. Thus, all the critical elements which are well taught by the cited reference and thus, the claimed subject matter is obvious variation and not patentably distinct over the prior art of the record.*

Applicants respectfully disagree. It appears that the only way the skilled artisan could arrive at Applicants' claimed invention is to pick and choose from the encyclopedia-like disclosure of Vatter using Applicants' disclosure as a guide. Such hindsight reconstruction in an obviousness determination is not in accordance with the law.

Vatter is directed to cosmetic compositions that contain two different types of silicone elastomers, emulsifying and non-emulsifying. Silicone elastomers are not silicone resins. Rather, they are a certain type of silicone that provides a unique tactile feel to cosmetic compositions into which they are incorporated. Vatter states in Col. 1, lines 55-65 that one object of his invention is to provide compositions with unique feel properties that are capable of carrying relatively high levels of moisturizing ingredients to the skin. This is accomplished by using a non-emulsifying siloxane elastomer (already well known for providing a unique tactile effects) and a siloxane elastomer that has emulsifying properties, which also provides surfactancy properties. Vatter further teaches that that this composition can contain a huge variety of other ingredients so long as the two types of elastomers are present. The Examiner has selected three lines from approximately about 2,500 lines of text (34 columns)--the silicone resin mentioned in Col. 12, line 39; the silicone acrylate polymer mentioned in Col. 12, line 49; and the linear volatile silicone mentioned in Col. 8, line 45; and concluded that it would be obvious to combine those specific items, in particular, to arrive at Applicants' invention. The motivation for this combination, according to the Examiner, is that such variations are considered to be minor and the modifications routinely practiced; that one having ordinary skill in the art would be able to adjust and employ the different ingredients to arrive at the desired quality. Even further, in the Examiner's analysis certain other critical limitations of Applicants' claims are completely ignored....specifically that the composition contains organic pigments that form the main color component of the composition and that the composition is free of inorganic pigments. Also apparently ignored are the limitations in many of the dependent claims.

Thus, the Examiner fails to address several critical limitations of Applicants' base claim, much less point out why or how Vatter would teach or suggest a composition comprising at least

one silicone acrylate or vinyl silicone copolymer, at least one silicone resin, at least one volatile linear silicone, said composition containing organic pigments that form the main color component of the composition and being free of inorganic pigments.

Vatter teaches that pigments may be used in Vatter's compositions. The compositions in the examples contain inorganic pigments such as iron oxides. Where is there any suggestion in Vatter that Applicants' specific compositions, where the organic pigment forms the main color component of the composition and the compositions are free of inorganic pigments, would provide any advantage? In ascertaining the unpatentability of claims over Vatter the Examiner must consider all the claim limitations, not just limitations that are taught in the references she cites.

As stated in Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996), a conclusion of obviousness premised on a combination of references must identify a reason, suggestion, or motivation, which would have led an inventor to combine those references. In this situation it is the suggestion that is missing. No where within the four corners of Vatter is there any suggestion that combining the specific ingredients and limitations in Applicants' claims – a silicone resin, a silicone acrylate copolymer, and a linear volatile siloxane, in an emulsion composition that contains organic pigments forming the main color component of the composition, and being free of inorganic pigments, would provide any advantage at all. If this deficiency is cured by any of the other references cited by the Examiner – Shah, McDermott, or the Zuckerman article, the Examiner has not explained how. The only way the Examiner can arrive at the invention defined in the claims is to pick and choose the individual claim limitations from Vatter either alone or in combination with the other references, using Applicants' disclosure as a guide.

The Examiner further responds to Applicants' arguments submitted May 26, 2006 stating:

*This examiner's position is that the claims are broadly drafted where the scope of the claims is encompassed by the teaching of Vatter's patent. All the critical elements required by the instant claims are well taught in the cited reference and thus, the claimed subject matter is not patentably distinct over the prior art of the record. Elements required by claims are well taught by the Vatter's patent (US049). And the final product including optional ingredients (additives) is easily manufactured by one of ordinary skill in the art with the methodologies suggested by Vatter's to maximize extra benefits by adding said additives. The instant claims which are drawn to a composition comprising a film forming agent (e.g. silicone resin + a silicone/acrylate copolymer or vinyl/silicone copolymer; and organic pigment and a volatile silicone oil in oil phase are well taught by the cited patent. And thus, the claims are not patentably distinct over the prior art of record.*

Again, the Examiner has failed to consider all the limitations of Applicants' claims in rendering them obvious over Vatter. Not considered is the significant claim limitation that the composition contains organic pigments that form the main color component of the composition. Also not considered is the significant limitation that the composition is free of inorganic pigments. Also, apparently, not considered are the many limitations in Applicants' dependent claims. In considering the patentability of a claim the Examiner must consider ALL the claim limitations, not just the limitations allegedly taught in the reference being cited.

The Examiner further contends that Applicants' arguments do not comply with 37 C.F.R. §1.111(c) because:

*they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited. Further, they do not show how the amendments avoid such references. Applicants' arguments fail to define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. McDermott's and Shah's references support the examiner's position where it is routinely mix [sic] more than one film forming agent to add benefits. Thus, the claimed invention utilizing more than one film forming agent is not novel over Vatter's patented product.*

Again, in the Examiner's analysis, significant limitations of Applicants' claims are ignored. The Examiner concludes that Applicants have failed to point out the patentable novelty; that the combination of film forming agents is not novel over Vatter's patented product. Applicants' claim is directed to more than a composition containing a combination of two film formers. Rather, the claimed composition is directed to an emulsion cosmetic composition comprising at least one silicone acrylate or vinyl silicone copolymer, at least one silicone resin, at least one linear volatile dimethicone, where the composition contains organic pigments that form the main color component of the composition and where the composition is free of inorganic pigments. For the Examiner to judge Applicants' claims unpatentable and obvious, only considering some, but not all of the claim limitations, is not appropriate. The pending claims are rejected over Vatter, either alone or in combination with McDermott and/or Shah. The Examiner must consider all of the claim limitations when reaching this conclusion, and show how the references either alone or in combination provide some suggestion that an advantage would be derived from combining their teachings to arrive at the invention of the claim, that is the invention defined by all of the claim limitations.

Similarly, the Examiner appears to disregard the limitations in Applicants' dependent claims. For example, in claims 3 and 4 that depend on claim 1, where do the references suggest the advantage in having organic pigments that are soluble or dispersible in an aqueous phase? And what about claim 6 where the organic pigment used has a very specifically enumerated color? And it is especially surprising that claim 7 would be rubber stamped obvious—a claim directed to a composition that provides a black or dark brown color to the eyes or skin to which it is applied, with the color being

achieved by combining organic pigments selected from red, green, blue, yellow, violet, organic, and mixtures thereof. Where is such a thing suggested by any of the references of record? If it is, the Examiner has not pointed it out. And what about any analysis with respect to claims 8-14 where the specific chemical nature of the organic pigments is stated. And claim 15, which specifies one very specific linear volatile silicone.

It appears to Applicants that the Examiner just glosses over their claims, picking some, but not all of the limitations from their base claim, claiming the selected limitations are taught in Vatter so the invention is obvious; failing to even consider all of the claim limitations in the broad claim much less the many significant limitations in their dependent claims.

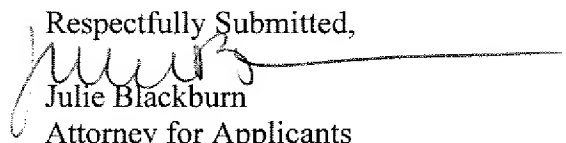
It is Applicants' position that Vatter, teaching compositions that contain inorganic pigments, provides no suggestion that a composition containing organic pigments forming the main color component of the composition and being free of inorganic pigments, would provide any advantage. Nor does the Examiner articulate in the office action how Shah or McDermott would cure these deficiencies in Vatter. Further, considering the limitations set forth in Applicants' dependent claims, the Examiner's conclusion of obviousness seems to be nothing more than a rubber stamping operation.

It is Applicants' position that when all of the claim limitations in both the broad claim and the dependent claims are considered, they describe a cosmetic composition that is not obvious over the references. There is simply nothing in Vatter either alone or in combination with Shah and/or McDermott, that teaches or suggests any advantage to be derived from combining their teachings to arrive at an emulsion cosmetic composition containing at least one silicone acrylate or vinyl silicone copolymer, at least one silicone

resin, at least one linear volatile silicone, and organic pigments forming the main color component of the composition, where the composition is free of inorganic pigments.

It is respectfully requested that the Examiner reconsider patentability of the claims.

Respectfully Submitted,



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